

### REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Office Action dated June 25, 2008. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

#### Status of the Claims

As outlined above, claims 1-4 stand for consideration in this application, wherein claims 1-3 are being amended. In addition, new claim 4 is hereby submitted for consideration.

All amendments to the application are fully supported therein, including page 7, lines 2-8 of the specification and Fig. 2. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

#### Formal Rejections

Claims 1-3 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1-3 are being amended so as to meet the requirements under 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of the rejections of claims 1-3 is respectfully requested.

#### Prior Art Rejection

##### 35 U.S.C. §103(a) Rejection

Each of claims 1-3 was rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Ballantyne (U.S. Pat. No. 5,867,821) in view of Kitahara (U.S. Pub. No. 2002/0087553). Applicants respectfully traverse this rejection for the reasons set forth below.

First, The Examiner asserted that, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, citing *In re Squineheart* (439 F.2d 210 (CCPA 1971)) and *Schreiber* (128 F.3d 1473 (Fed. Cir. 1997)). Applicants respectfully believe that both *In re Squineheart* and *Schreiber* are not applicable to claims 1-3. In both *In re Squineheart* and *Schreiber*, the court found that claims recited newly discovered functions

of elements having the same or equivalent structures as those of the prior art. The court also found that the newly discovered functions were inherent to the elements.

In contrast, functions recited in claims 1-3 as amended are not inherent to a medical information control device, which is one of the elements of a medical support system as recited in claims 1-3, and thus not newly discovered functions of the medical information control device. It is well established that a function(s) of an element recited in a claim is considered to be an element to determine the scope of the claim, if it is not inherent to the element. Therefore, the functions recited in claims 1-3 should be considered elements, among others, that determine the scope of the claims.

### Claim 1

A medical support system as recited in claim 1 comprises patient terminals configured to be used individually by a plurality of patients; medical institution terminals configured to be used individually by a plurality of medical institutions; and a management server, each patient terminal being connected with the medical institution terminals and the management server via a network, the medical institution terminals being connected with the management server via a network. Said management server comprises a medical information storage device for storing medical information of each patient and a medical information control device for controlling an input and output of said medical information of each patient into and from said medical information storage device, the medical information including medical records, examination results, and medical images. Said medical information control device is configured to, upon receiving a request from a patient terminal of a first patient among the plurality of patients to upload in said management server medical information of said first patient managed by a medical institution among said plurality of medical institutions, transmit upload permission key data for uploading said medical information of said first patient in said management server and a content of said medical information of said first patient to be uploaded by the request to said medical institution terminal of said requested medical institution; upon receiving said upload permission key data transmitted from said medical institution terminal, authenticate validity of said upload permission key data, transmit to said medical institution terminal a permission response for transmitting said medical information of said first patient to said management server, and defer upload of said medical information of said first patient; and upon receiving said medical information of said first patient transmitted from said medical institution terminal, store said medical information of said first patient in said medical information storage device. These features enable a

management server to intervene control over a transaction on a patient's medical information between a patient terminal and a medical institution terminal.

In contract, neither Ballantyne nor Kitahara shows or suggests the features of a medical information control device as recited in claim 1. Therefore, at the time the invention was made, one of ordinary skill in the art could not and would not achieve all the features as recited in claim 1 by combining Kitahara with Ballantyne. Accordingly, claim 1 is not obvious in view of all the prior art cited.

#### Claims 2-4

Claims 2-4 have substantially the same features as those of claim 1. As such, the arguments set forth above are equally applicable here. Claim 1 being allowable, claims 2-4 must also be allowable.

Particularly, with respect to claim 3, the Examiner asserted that it is a predictable result that other hospitals can access patient information while they are connected to a server. However, a medical support system as recited in claim 3 is not purported to allow other hospitals access patient information while they are connected to server. Rather, upon receiving a permission response from said patient terminal of said first patient to permit said second medical institution to download and view said medical information of said first patient, said medical information control device in a medical support system recited in claim 1 can transmit download permission key data to permit said second medical institution to download to and view said medical information of said first patient on said second medical institution terminal. These features are not predictable in view of Ballantyne and Kitahara

In sum, claims 2-4 are not obvious in view of all the prior art cited.

#### Conclusion

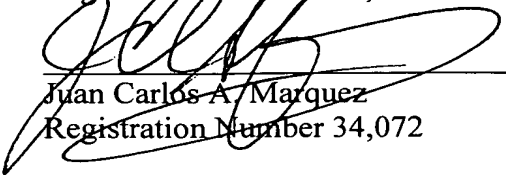
In light of the above-noted Amendments and Remarks, Applicants respectfully request early and favorable action with regard to the present application, and a Notice of Allowance for all pending claims is earnestly solicited.

Favorable reconsideration of this application as amended is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the

prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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